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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,408	02/07/2000	SIEGFRIED WILHELM	2345/115	1878

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EXAMINER

BOWES, SARA E

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 02/02/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/485,408

Applicant(s)

WILHELM ET AL.

Examiner

Sara Bowes

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) 22-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/7/2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Status of Claims

Claims 15-21 are pending.

Claims 22-27 are withdrawn.

Election/Restrictions

Applicant's election of Group 1: claims 15-21 in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

This application contains claims 22-27 drawn to an invention nonelected in Paper No. 6. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 72. STB is labeled 72, it is suggested that it be relabeled 12.

The drawings are objected to because the following components and their reference sign(s) mentioned in the description do not correspond to the labeling of the figures.

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In figure 2, RCU is discussed in the specification as 42; however is labeled 34 in the figure. Also in figure 2, IFD is discussed in the specification as 34; however is labeled 36 in the figure. Further review of the figures is suggested by the Examiner to ensure correctness.

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. Figure 1 is described as "customary today" [page 7, line 10] thus requiring a Prior Art label.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The

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disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because legal phraseology is used in lines 2, 4, and 9 of the Abstract.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,534,913 to Majeti et al. in view of U.S. Patent No. 5,029,207 to Gammie.

Referring to claim 15, Majeti et al. teach a decoder device for decrypting encrypted television programs, the decoder device comprising:

a control unit [figure 4, HOME CONTROLLER 122];

a second interface for interfacing to the control unit [figure 5, 132];

a third interface for interfacing to a telecommunications network [column 3, lines 59-67].

Majeti et al do not teach a decoder device for decrypting encrypted television programs, the decoder device comprising:

an input for receiving the encrypted television program;

a decryption device for decrypting the encrypted television program into a format reproducible by a television set;

an output capable of being connected to the television set so as to output the decrypted television program to the television set for reproduction;

a first interface for interfacing to at least one of a first identification and a first key carrier component for enabling the decryption device, the first interface being disposed in the control unit; and

a fourth interface for interfacing to at least one of a second identification and a second key carrier component, an authorization by at least one of the second identification and the second key carrier component being useable for establishing a connection to a subscriber via the telecommunications network.

However, Gammie discloses a decoder device comprising:

an input for receiving the encrypted television program [figure 5, SATELLITE LINK 505];

a decryption device for decrypting the encrypted television program into a format reproducible by a television set [figure 5, PROGRAM DESCRAMBLER 508];

an output capable of being connected to the television set so as to output the decrypted television program to the television set for reproduction [figure 5, OUTPUT 509];

a first interface for interfacing to at least one of a first identification and a first key carrier component for enabling the decryption device, the first interface being disposed in the control unit [figure 5, replaceable security module 514]; and

a fourth interface for interfacing to at least one of a second identification and a second key carrier component, an authorization by at least one of the second identification and the second key carrier component being useable for establishing a connection to a subscriber via the telecommunications network [figure 5, replaceable security module 514 and column 6, lines 49-53].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Gammie's teachings of decrypting the received programs for a conditional access television system to the system and method of Majeti et al. such that Majeti et al.'s system would include a smart card reader in the HOME CONTROLLER for reading decryption keys/identification from smart cards. The decryption keys would then be sent to the decryption device newly placed in the set top box. One would have been motivated to modify Majeti et al.'s system as such in order

to provide higher security for the transmitted program information [column 6, lines 48-50]

Referring to claim 16, Majeti et al. as modified teach the decoder device as recited in claim 15 wherein the fourth interface is disposed in the control unit [figure 5, replaceable security module 514 and column 6, lines 49-53].

Referring to claim 17, Majeti et al. as modified teach the decoder device as recited in claim 15 wherein the television set includes a fifth interface for receiving control commands and wherein the control unit is capable of controlling the television set [column 12, line 37-column 13, line 3].

Referring to claim 18, Majeti et al. as modified teach the decoder device as recited in claim 15 wherein the first and the second identification and/or key carrier components include a respective smart card or a common smart card [column 11, lines 63-65 to Gammie].

Referring to claim 19, Majeti et al. as modified teach the decoder device as recited in claim 15 further comprising a sixth interface for connecting the decoder device to a computer [figure 1, 72 to Majeti], the computer being adaptable for at least one of controlling the decoder device and establishing a connection to a subscriber via the telecommunications network [figure 1, MODEM 76].

Referring to claim 20, Majeti et al. as modified teach the decoder device as recited in claim 15 wherein the control unit includes a computer, the computer including a seventh interface for controlling the decoder device and including the first and fourth interfaces [figure 1, PERSONAL COMPUTER 74 and HOME CONTROLLER 70].

Referring to claim 21, Majeti et al. as modified teach all limitations of claim 21 except for the limitation of the decoder device is integrated in the television set.

However Gammie discloses the decoder device is integrated in the television set [column 6, line 26-28 of Gammie].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Gammie's teachings of integrating the decoder into the television set to the system and method of Majeti et al. One would have been motivated to modify Majeti et al.'s system as such in order to make for a more compact unit [column 6, lines 26-28].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,644,354 to Thompson et al.;

U.S. Patent No. 5,594,493 to Nemirofsky;

U.S. Patent No. 5,237,610 to Gammie et al.;

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U.S. Patent No. 5,481,609 to Cohen et al.;

U.S. Patent No. 4,768,229 to Benjamin et al.;

U.S. Patent No. 5,616,876 to Cluts;

U.S. Patent No. 5,204,663 to Lee.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Bowes whose telephone number is 703-305-0326.

The examiner can normally be reached on 7:30-4:00, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

seb
1/9/2004


SAFET METJAHIC
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